

REMARKS

Claims 1-24 and 42-46 are pending in this application. For purposes of expedition, claims 1-4, 17, 20, 21 and 24 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

Claims 1-4 are rejected under 35 U.S.C §101 because it relates simply to a data storage medium. Specifically, the Examiner alleges that "merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory", and that "it is not statutory since no requisite functionality is present to satisfy the practical application requirement." In response thereto, base claim 1 has been amended to ensure that a practical application is present, that is, "sub data recorded in a separate bitstream from the main data is to be reproduced in synchronization with the main data by a reproducing apparatus", and "navigation information defining a relation required for the main data and the sub data to be output in synchronization with each other by the reproducing apparatus". As amended, Applicants believe that the rejection is now deemed moot and should be withdrawn.

Claims 1-4, 5-24, and 42-46 have been rejected under 35 U.S.C. §102(e) as being anticipated by Suzuki. However, the Examiner never identifies which Suzuki reference is being applied in support of the rejection of claims 1-4, 5-24 and 42-46. As a result, Applicants assume that the Suzuki reference is U.S. Patent No. 6,763,178. However, Suzuki '178 does not disclose key features of Applicants' base claims 1, 5, 13, 17 and 21 as mistakenly alleged by the Examiner. For example:

Base claims 1 and 5 define a data storage medium and a method of recording main data including audio data and/or video data, in which "main data" and "sub data" are recorded along with "navigation information" so as to be reproduced in synchronization with the main data in a separate bitstream from the main data, and such "navigation information" is used to define a relation required for the main data and the sub data to be reproduced in synchronization with each other. Such navigation information refers to control information required for easy searching and controlling multimedia contents stored in storage media, and includes identifiers for particular bitstreams and playback time information on additional data corresponding to main data.

Similarly, base claim 13 defines a reproduction method in which, among other features,

the read main data and the read sub data are mixed based on navigation information defining a relation required for the read main data and the read sub data to be reproduced in synchronization with each other. Likewise, base claims 17 and 21, as amended, also define similar features, and further require "extra data" which is also read based on navigation information defining a relation required for the read sub data and extra data to be reproduced in connection with each other.

In contrast to Applicants' base claims 1, 5, 13, 17 and 21, Suzuki '178 only discloses a method and apparatus, as shown in FIG. 1, for recording video with superimposed sub-information. According to Suzuki '178, audio data and graphics data representing sub-images such as subtitles are to be superimposed with main images of the video data. Main data comprised of the video and audio data are then compression encoded, multiplexed and recorded on a record medium such as a magnetic or optical disk. The graphics data are arranged in at least one file separate from the main data, and separately recorded on the recording medium, such that, during reproduction, the graphics data file is read from the record medium at different times than the main data, and buffered separately. Since the arrangement and recording of the graphics data are done in separate files, editing and playback operations can be simplified.

However, there is no disclosure anywhere in Suzuki '178 of Applicants' claimed "navigation information [used to define] a relation required for the main data and the sub data to be reproduced in synchronization with each other" as defined in base claims 1 and 5, or alternatively, "a relation required for the read main data and sub data to be reproduced in synchronization with each other and for the read main data and extra data to be reproduced in connection with each other" as defined in base claims 17 and 21.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). In addition, the prior art reference must be enabling. Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed.

Cir. 1986), cert. denied, 482 U.S. 909 (1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Suzuki '178 fails to disclose and suggest key features of Applicants' base claims 1, 5, 13, 17 and 21. Therefore, Applicants respectfully request that the rejection of claims 1-4, 5-24 and 42-46 be withdrawn.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Stein, McEwen & Bui, LLP, No. 503333, and credit any excess fees to said deposit account.

Respectfully submitted,

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